

thereof.

25. 1. The compound according to claim 1 which is 5-  
difluoromethoxy-2-[(3,4-dimethoxy-2-pyridyl)methylsulfinyl]-1H-  
benzimidazole sodium salt. ~~etc.~~

R E M A R K S

Favorable reconsideration is respectfully requested in view  
of the preceding amendments, the accompanying evidence and the  
following representations.

The newly-presented claims are directed to compounds for  
which data are provided in the accompanying Declarations. As  
the number of claims has been increased by three, a remittance  
in the amount of \$36.00 is submitted herewith. In the event of  
any fee deficiency, kindly charge such deficiency to Deposit  
Account No. 02-2122, and advise the undersigned accordingly.

As this paper was substantially prepared prior to and as  
a basis for the interview (see Paper No. 22) which took place  
on December 17, 1987, much of what was discussed during the  
interview is reflected herein.

The rejection of claims 1 to 19, 21, 22 and 24 to 27 "under  
35 USC 103 as being obvious over patent No. 4,555,518 (Rainer  
'518), or 4,560,693 (Rainer '693) in view of 4,255,431  
(Junggren) for reasons of record" is respectfully traversed for  
the following reasons:

1. In view of the fact that each of the Rainer patents

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-2-

expressly limits each of R<sub>2</sub> and R<sub>4</sub> to "hydrogen or a 1-3C-alkyl radical", any modification thereof must be regarded as contrary to the teachings of each of these references.

2. Junggren has six variables; nothing is found in the entire applied prior art that would lead any artisan to select (specifically) R<sup>3</sup> and R<sup>5</sup> to vary in a prescribed manner when concurrently selecting either methoxy or ethoxy as the definition for R<sup>4</sup>. In addition, no incentive to make such selection is provided. Moreover, no reason is found to modify either Rainer reference in any particular way, based solely on Junggren's teachings. Clearly, there is no record reason to believe that the particular modification called for by Applicants' claims would increase the stability of corresponding compounds. Such increase in stability must be regarded as an unexpected and unobvious result, which is expressly stated in Applicants' disclosure (page 2, paragraph starting at line 16; second paragraph on page 51). The prior art lacks any teaching or suggestion that stability might be improved in this specific manner.

Whenever a reference is evaluated for its availability under 35 U.S.C. 103, it must satisfy certain criteria which are set forth in the opinion for *In re Horn, Horn, Horn & Horn*, 203 USPQ 969 (CCPA 1979), at 971:

For the teachings of a reference to be prior art under 35 USC 103, there must be some basis for concluding that the reference would have been

considered by one skilled in the particular art working on the pertinent problem to which the invention pertains. For no matter what a reference teaches, it could not have rendered obvious anything, "at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains," unless said hypothetical person would have considered it.

Applicants respectfully request the PTO to explain how Junggren, who is completely silent with regard to compound stability, satisfies the criteria quoted from the cited opinion. The absence of satisfying those criteria on the record of this prosecution will be regarded as an admission by the PTO that Junggren is not truly available under 35 USC 103.

3. Junggren lacks enablement for preparing any compound within the scope of Applicants' claims. Please note that Junggren fails to refer to any particular compound with dialkoxy substitution on the pyridyl ring. Moreover, Junggren fails to teach any way of making intermediates required to produce dialkoxy pyridine compounds. In fact, 3,4-dialkoxy pyridine compounds needed as intermediates were not known in the art at the time (April 5, 1979) of Junggren's filing date. As there was no known way to make such compounds at the time of Junggren's filing date, his teachings truly fail to include any compound having the necessary dialkoxy substitution. In this regard, please note the second complete paragraph on page 22 of Applicants' specification. A non-enabling disclosure with regard to specific substitution relied upon does not

satisfy the requirements for a viable reference.

4. As previously pointed out, Applicants' disclosure clearly teaches increased chemical stability of the claimed compounds. The PTO has failed to provide any evidence or reason to doubt Applicants' disclosure in this regard. As pointed out in the opinion for *In re Marzocchi and Horton*, 169 USPQ 367 (CCPA 1971), at 370:

...it is incumbent upon the Patent Office...to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure. . .

5. It really does not make any difference what effect a particular chemical modification has on involved structures beyond that relied upon by Applicants. Since the stability imparted by the subject chemical modification is truly improved, what concurrently may happen to other properties of the compounds is substantially irrelevant. The alteration in properties brought about by Applicants' claimed invention must be regarded as unobvious since there is no prior-art suggestion that stability might be improved in the manner taught by Applicants. This is the test of 35 USC 103, and nothing more should be required. Even were the PTO rationale viable, Applicants still found an unexpected and unobvious way of bringing about any unexpected result. The statute requires no

more.

6. The PTO refers to *In re De Montmollin*, 145 USPQ 416. The facts at hand distinguish over the opinion in that case in the same manner as provided by the opinion for *In re Murch*, 175 USPQ 89 (CCPA 1972) at 92:

The blend defined therein shares the common significant property of good blend toughness but additionally possesses unexpectedly superior weld line toughness. There is one very crucial distinction, however, between Mod and De Montmollin on the one hand and the present case on the other. The fact here is that the prior art is not merely silent on the matter of weld line toughness, but appellant has proved that the closest blends disclosed in the prior art possess *inferior* weld line toughness. In this sense, the present case is closer to *In re Ackermann*, *supra*, wherein the claims were drawn to a compound which in its pure state was a superior optical brightener for polyester fibers.

Similarly, Applicants have established that the most-closely related prior-art counterparts indeed lack the stability possessed by Applicants' corresponding counterparts.

7. Compounds 1 to 3, 10, 19, 22 and 27 are included in Dr. Kruger's Declaration of April 24, 1987, to provide additional evidence that further modification of involved structures according to prior-art teachings similarly fails to produce the level of stability achieved by Applicants' claimed structures.

8. The position stated in paragraph 3 in the Office Action of September 1, 1987, is not understood. As previously pointed out, there is no need for Applicants to substantiate

statements in their disclosure in the absence of evidence or good reason to believe that their statements are false. No such evidence or rationale has been provided on the record of this case. There is no requirement for Applicants to prove statements in their disclosure under prevailing circumstances. Applicants have carefully reviewed the opinion for *In re Johnson*, 223 USPQ 1260 (Fed. Cir. 1984), and have been unable to find a direct relationship between that opinion and the prevailing facts in the prosecution of this application. If the opinion is to be relied upon for any purpose, Applicants respectfully request that the specific language of the opinion relied upon be expressly set forth on the record of this case and be applied directly to what the PTO regards as relevant facts of this case. The absence of such direct application on the record must be regarded as an admission by the PTO that the opinion relied upon is not pertinent.

9. Even (purely arguendo and without admission) were Junggren's teachings actually generic to Applicants' claimed invention, and they are not, instantly-claimed compounds would constitute a "selection" invention for which patentability would not be precluded. The compounds have an unexpectedly-improved stability, which, not only, is not even remotely suggested by Junggren, but is not possessed by the most-closely-related counterparts actually disclosed by Junggren. Reference in this regard is respectfully made to pages 3 and 4

of Applicants' amendment of January 27, 1987. No response to either the presented argument or the supporting opinion is provided by the PTO. As Applicants are entitled to have an explanation as to why provided arguments failed to support patentability (35 USC 132), Applicants respectfully request a direct response to each of their stated positions in the event that their claims are not allowed forthwith.

The rejection of claims 1 to 19, 21, 22 and 24 to 27 "under obvious-type double patenting rejection over art of record" is respectfully traversed in the same manner and for the same reasons as set forth in the preceding discussion. Moreover, Applicants note that there is, presently, considerable art of record. This entire ground of rejection is meaningless without the specific identification of the particular "art of record" relied upon and the manner in which it is relied upon. As stated, the ground of rejection defies response beyond that previously presented in these remarks. Clarification of the particular "art of record" relied upon and the manner in which such art is relied upon is respectfully solicited in the event that this ground of rejection is retained.

The rejection of claim 1 "under 35 U.S.C. 112, first and second paragraphs" is also respectfully traversed. With reference to "Hackh's Chemical Dictionary", 4th edition, page 254 (copy herewith), McGraw-Hill Book Company, 1969, ethylene dioxy is the radical -OCH<sub>2</sub> CH<sub>2</sub>O-. The structure of

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chlorotrifluoroethylene dioxy is thus clearly  $-O-CClF-CF_2-O-$  or  $-O-CF_2-CClF-O-$ , which is the identical radical in the context of Applicants' disclosure. This is confirmed by the paragraph starting at line 24 on page 13 of the specification.

The rejection of claims 1 to 19, 21, 22 and 24 to 27 "under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of copending application serial No. 794,230" is also respectfully traversed. This very ground of rejection was expressly withdrawn on February 3, 1987, by Paper No. 11.

Claim 5 of the cited application corresponds with claim 5 of USP 4,686,230 (Rainer '230). Applicants respectfully request the PTO to point out the "overlapping subject matter" between claim 5 of '230 and any of the claims of the subject application. In addition to the fact that claim 5 of '230 defines R6 so that it is alkyl rather than hydrogen, as required by Applicants' claims, there are other clear distinctions. As claim 5 of '230 is dependent from claim 1 of that patent, it has all of the limitations of claim 1. Claim 1 of '230 has a number of restrictions (starting at column 42, line 59). In order to compare claim 1 of '230 with claim 1 of the subject application, please note the following:

Rainer '230

Present Application

R4 in 5-position

R1-O- in 5-position

R1 in 1-position = -H

R2 in 6-position (column 42  
lines 62 to 66) cannot have  
a meaning corresponding  
to R1' of the application

R1'' in 6-position

R3 in 6-position (column 42,  
lines 67 and 68) cannot have  
a meaning corresponding to  
R1' of the application

As there are 4 substituents  
(R1, R2, R3 and R4) on the  
benzimidazole ring and only  
4 available positions on that  
ring, one of R2 and R3 must be  
in the 6-position and the other  
must be in the 7-position.

The very alleged bases ("overlapping subject matter")  
relied upon for this ground of rejection is thus seen to be  
nonexisting not only with regard to claim 5 of '230, but also  
with regard to claim 1 of that patent.

Applicants Information Disclosure Statement of February  
27, 1987, directs attention to an EPO published application  
(Brown) which was published on October 17, 1979, i.e. subsequent  
to Junggren's filing date. This published application  
comprises the earliest-known published teaching related to 2-hydroxy  
methyl-3,4-dimethoxypyridine (page 16, lines 10 and 11) and 2-  
chloromethyl-3,4-dimethoxypyridine (page 16, line 14 and 15).  
This cited text was expressly referred to in Applicants'  
remarks of February 27, 1987.

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As previously noted, two further Declarations are submitted herewith. The conclusions from the test data obtained are expressed by the expert declarants in the respective Declarations. Even though Applicants submit that presentation of evidence should not have been necessary under the prevailing circumstances, they are providing this additional evidence in order to overcome the outstanding adverse position and thus facilitate the termination of these proceedings.

Having overcome all outstanding grounds of rejection, an early notice of allowance is respectfully solicited.

Respectfully submitted,

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